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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/770,139	02/02/2004	John P. Downs	5398-CIP-CON-3	9662
22922 7590 10/30/2007 REINHART BOERNER VAN DEUREN S.C. ATTN: LINDA KASULKE, DOCKET COORDINATOR 1000 NORTH WATER STREET SUITE 2100 MILWAUKEE, WI 53202			EXAMINER AHMAD, NASSER	
			ART UNIT 1794	PAPER NUMBER
			MAIL DATE 10/30/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/770,139	Applicant(s) DOWNS, JOHN P.	
	Examiner Nasser Ahmad	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5,7,9-14,16 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5,7,9-14,16 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) <input type="checkbox"/> Notice of Informal Patent Application
6) <input type="checkbox"/> Other: _____ |
|--|--|

DETAILED ACTION

Rejections Withdrawn

1. Claims 1, 3, 5, 7, 9-14, 16 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Torrey (3741786) made in the Office Action of 3/30/2007 has been withdrawn in view of the amendment filed on 8/24/2007.

Response to Arguments

2. Applicant's arguments with respect to claims 1, 3, 5, 7, 9-14, 16 and 20 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3, 5, 7, 9-14, 16 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Torrey (3741786).

Torrey relates to an adhesive dispensing tape (10) comprising a flexible carrier tape (12) having a transverse width, a row of adhesive segments (14) spaced apart along the longitudinal length of the tape and transversely in side-by-side relation, each segments being disposed between the two side edges, and can be transferred by flexing the tape. The adhesive is pressure sensitive adhesive (PSA) (col. 3, line 30) and applied to the

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carrier in a hot melt form, hence it includes hot melt adhesive. The carrier tape is provided with first and second release surfaces such that the adhesive segments adhere less strongly to the second release surface when unwound from a roll (col. 2, lines 8-12 and col. 3, lines 5-12). The adhesive segments are centered along the transverse width of the tape to form a longitudinally straight line as shown in figure-1. The segments can be of any shape such as dots, bars, star, triangle, etc. or any pattern without any criticality (col. 3, lines 57-68). The dot shape would exhibit circular configuration. The transverse position of each segment is distinct as shown by their separate position along the tape length. In col. 6, lines 32-37, Torrey teaches that any portion of the adhesive can be transferred from the carrier tape to a substrate, thereby indicating that each adhesive segments is individually exposable and dispensable. Further, figure-1 shows that the each of the tape edge is at least equal to the adhesive segments. However, Torrey fails to teach that the adhesive segments are aligned in sided-by-side relation. It would have been obvious to one having ordinary skill in the art to modify Torrey by providing the adhesive segments as aligned in side-by-side relation at transversely separated locations, since such a modification would have involved a mere change in the pattern or design of the adhesive segments in the longitudinal segments of the carrier tape, as such a change in pattern provides for aesthetic appeal. Regarding claims 3, 11, 20, Torrey, in col. 2, lines 8-22, teaches that the adhesive segments adhere less strongly to the second release surface than they do to the first release surface of the carrier tape.

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The intended use phrases such as "to an abutting planar surface when the carrier tape is transversely flexed" have not been given any patentable weight because said phrases are not found to be of positive limitations.

For claim 5, Torrey clearly discusses that the shape of the adhesive segments are not critical and it can have any desired shape. Thus, it would have been obvious to one having ordinary skill in the art to modify Torrey by providing its adhesive segments in a disc shape, since such a modification would have involved a mere change in the shape of a component. A change in shape is generally recognized as being within the level of ordinary skill in the art. *In re Dailey*, 149 USPQ47 (CCPA 1976).

For claim 9, see Torrey, figures 1 and 4, which shows that the adhesive segments are substantially linearly disposed along the length of the tape.

Regarding claim 10, figure-4 of Torrey shows that the adhesive segments are located between the first and second edges of the carrier tape.

For claims 12, 13, the separation distance between the adhesive segments are obvious matter of design choice modification for optimizing the adhering properties.

Response to Arguments

5. Applicant's arguments filed 8/24/2007 have been fully considered but they are not persuasive.

Applicant argues that Torrey's tape is not provided for aesthetic appeal, it is purely functional. This is not found to be convincing because the adhesive segments provide

for the functional properties of the tape, while the adhesive segments can be provided in a pattern, such as a side-by-side relation, for imparting aesthetic appeal, without affecting the adhesive functional properties.

Responding to applicant's arguments that Torrey fails to disclose that *each individual adhesive segment is individually exposable and dispensable to an abutting planar surface when the carrier tape is transversely flexed*, applicant is informed that said phrase is directed to an intended use of the claimed tape as to when it is used with a planar surface. This phrase is not found to be of positive limitation for the claimed tape structure.

For applicant's argument that Torrey's adhesive segments are not dispensed individually, applicant is directed to col. 6, lines 32-37, wherein Torrey teaches that any portion of the adhesive can be transferred from the carrier tape to a substrate, thereby indicating that each adhesive segment is individually exposable. Further, Torrey states that the pattern of the adhesive segments are not critical, any pattern would have been obvious matter of design choice.

Thus, in the absence of any evidence to the contrary, it remains the examiner's position that the claimed invention is anticipated or rendered obvious over the prior art of record discussed above.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

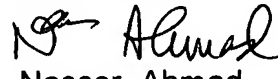
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Nasser Ahmad 10/26/07
Primary Examiner
Art Unit 1794

N. Ahmad.
October 26, 2007.